REMARKS

I. STATUS OF THE CLAIMS

Claims 1-8 and 12-16 remain pending in this Application. Claims 1-8 and 12-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Haworth et al. (U.S. Publication No. 2002/0123946) ("*Haworth*") and Cunningham (U.S. Patent No. 6,014,645) ("*Cunningham*").

II. STATEMENT OF COMMON OWNERSHIP

Under the provisions of M.P.E.P. § 706.02(l)(2), Applicant's undersigned representative of record supplies the following statement that the present application, U.S. Patent Application No. 09/812,831, and *Haworth* were, at the time the invention of the present application was made, owned and/or subject to an obligation of assignment to Capital One Financial Corp., as demonstrated in the assignment regarding the present application recorded on March 21, 2001 at Reel No. 011626, Frame No. 0885 and the assignment regarding *Haworth* recorded on April 4, 2001 at Reel No. 011721, Frame No. 0860. As a result, under 35 U.S.C. § 103(c), *Haworth* is not applicable prior art under 35 U.S.C. § 103 against the present application.

III. REJECTION UNDER 35 U.S.C. § 103

As noted above, the Examiner rejected claims 1-8 and 12-16 under 35 U.S.C. § 103(a) as being unpatentable over *Haworth* and *Cunningham*. Applicant respectfully traverses this rejection for at least the reason set forth below.

A. *Haworth* is Not Prior Art

Under 35 U.S.C. § 103(c), a § 103(a) rejection relying on a reference that qualifies as prior art under § 102(e) can be overcome by making a statement of

common ownership or an obligation of common ownership of the cited reference and the current application. 35 U.S.C. § 103(c) provides that:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claim invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Haworth qualifies as prior art under 35 U.S.C. § 102(e), and the § 103(a) rejection is thus subject to the conditions of § 103(c). Based on the Statement of Common Ownership set forth above Section II, Applicant respectfully asserts that *Haworth* is not available as prior art under 35 U.S.C. § 103(c). Applicant, therefore, respectfully requests the Examiner to withdraw the rejection of claims 1-8 and 12-16, which relies on *Haworth*.

B. *Cunningham* Does Not Disclose or Suggest Ranking of Offers

To establish a prima facie case of obviousness over a combination of references, the Examiner "bears the initial burden of factually supporting any prima facie conclusion of obviousness." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Federal Circuit has on numerous occasions stated that to establish a prima facie case of obviousness an Examiner must show that the references, taken alone or in combination, (1) teach all the present claim limitations; (2) would have suggested to or provided motivation for one of ordinary skill in the art to make the claimed invention; and (3) would have provided one of ordinary skill with a reasonable expectation of success in so making. *See In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). "Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the applicant's disclosure." *Id.*

The Examiner has not met these requirements here. In particular, the Examiner states *Haworth* fails to teach ranking the debt recovery offers, as recited in independent claims 1 and 14-16. (Final O.A. at 5.) The Examiner then attempts to rectify this deficiency by citing *Cunningham*. According to the Examiner, *Cunningham* "discloses ranking (or rating) credit card offers appropriate to a customer" and, therefore, that it would have been obvious to rank the offers of *Haworth*. *Id.*

As stated in Section III(A), however, *Haworth* is not available as prior art under 35 U.S.C. § 103(c). In the absence of *Haworth*, the Examiner has not provided *any* evidence to show that *Cunningham* meets the requirements for a prima facie case of obviousness of claims 1-8 and 12-16.

Moreover, the Examiner's characterization of *Cunningham* as disclosing ranking of credit card offers is incorrect. To the contrary, *Cunningham* discloses ranking or rating a customer's financial risk. Col. 4, lines 53-54 ("The grade/score assigned to the applicant by the grading system may be viewed as a financial risk rating.") *Cunningham* teaches using the applicant's grade/score to determine what credit card products to offer to the customer. See, e.g., col. 4, lines 17-20. Nowhere, however, does *Cunningham* disclose using the grade/score for "ranking the debt recovery offers" themselves, as recited in claim 1 and in similar language in claims 14-16. *Cunningham* discloses ranking applicants, not offers to applicants.

Thus, for the reasons above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-8 and 12-16 under 35 U.S.C. § 103(a) as being unpatentable over *Haworth* and *Cunningham*.

IV. CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of pending claims 1-8 and 12-16.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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